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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,984	02/03/2004	Robert A. Edmonds	EDT 002	3569

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EXAMINER

SCHLIE, PAUL W

ART UNIT PAPER NUMBER

2186

DATE MAILED: 02/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/771,984	Applicant(s) EDMONDS ET AL.	
	Examiner Paul W. Schlie	Art Unit 2186	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/26/04 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-37 have been examined.

Claim Rejections - 35 USC § 112

2. Claims 1-37 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. As elements critical or essential to the practice of the invention, are neither included in the claims nor enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

More specifically, as it's likely obvious that an object may be identified by it's fingerprint (colloquially defined as: identification by means of a distinctive mark or characteristic differentiating physical attributes), including the potentially unique relative position of otherwise non-distinctive marks as typically utilized to distinctly identify literal human fingerprints, and the claimed invention appears to rely on the relatively precise angular and/or radial location of otherwise non-distinctive symbols which must be implicitly be measured utilizing some means, other than their mere otherwise predictable relative presence within a spiral recording track, with a greater and provably sufficient precision than may be temporally estimated (as the disclosure itself relies on such a temporal variation as the basis of the potentially distinguishing measurement) but no such method is taught to enable one of ordinary skill in the art at the time of the invention to reliably determine such measurements to enable that claimed without likely undue experimentation; therefore the claims are not considered enabled.

Corrective action is required, however the applicant is reminded that no new matter may be added which is not supported by the original disclosure.

Claim Rejections - 35 USC § 102/103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-37 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Heylen (6,560,176).

As per independent claims 1, 12, 22, 27, 32 and 35, Heylen teaches that a method and/or apparatus to enable a digitally storage medium to be uniquely identified by at least one physical attribute of it's recoding surface, such that the attribute may be compared to a known attribute to determine its likely authentic origin (see abstract, column 1 lines 40-49, figures 1-2 and 7-8). Where although Heylen does not explicitly teach that said known attribute may be obtained from a database of such attributes and display the result of the comparison, it is considered logically inherent and/or obvious to one of ordinary skill in the art to combine that which is taught by Heylen relevant to these claims with the common knowledge that a database of such attributes may be

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utilized and that the result of the said comparison may be displayed, for the benefit of enabling the source of the likely authentic origin of the digitally recorded media to be communicated (similar to Heylen's related patent 6,535,469 although not used as the basis of rejection). Any limitations not otherwise considered explicitly addressed are correspondingly considered obviously inherent in that taught, clearly obvious to one of ordinary skill in the art at the time of the invention, and/or not sufficient to patentably distinguish over prior art.


As per claims 2-11, 13-21, 23-26, 28-31, 33-34 and 36-37, being dependant on claim 1, 12, 22, 27, 32, 35, or correspondingly dependant claim inclusively, Heylen further teaches: that such an identifying distinguishing attribute may comprise the relative angular position of two or more otherwise non-differentiated recorded symbols (see figures 1-2, being inherently modulated) recorded on a spiraling trajectory (thereby correspondingly inherently having distinct radial positions and inherently having a nearly distinct radial position as a function of the encoded data block within which its comprised); that such digital media may comprise a digital versatile disk (see column 1 lines 61-65); that such a digital media may comprise a master or derivative copy of some recording source (see column 3 lines 53-55). Any limitations not otherwise considered explicitly addressed are correspondingly considered obviously inherent in that taught, clearly obvious to one of ordinary skill in the art at the time of the claimed invention, and/or insufficient to patentably distinguish over prior art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul W. Schlie whose telephone number is 571-272-6765, or email address is [paul.schlie@uspto.gov]. The examiner can normally be reached on Mon-Thu 8:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Kim can be reached on 517-272-4182. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


PIERRE BATAILLE
PRIMARY EXAMINER
2/15/06